

Application No. 10/655,162
Reply to Office Action of 09/27/2004

REMARKS/ARGUMENTS

Claims 1-20 are cancelled in favor of new Claims 21-41. Support for the new claims is found throughout the specification and in the originally filed claims.

At the outset, Applicants thank Examiner Zemel for her helpful explanations of the rejections and suggestions to overcome the same in the Office Action dated September 27, 2004.

Applicants maintain the traversal of the restriction and election of species requirements even though Applicants have cancelled claims drawn to the non-elected subject matter, for the time being, so as to focus on the elected subject matter.

The rejections of Claim 1-4 and 8-15 under 35 USC §102(b) and/or 103(a) over either of US 2,284,156 (US'156) and/or US 6,054,606 (US'606) are believed to be obviated by the cancellation of such claims. In addition, new Claims 21-41 are neither anticipated, nor suggested, by US 2,284,156 (US'156) and/or US 6,054,606 (US'606).

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US'156 discloses, at best, a method of reacting a terpene-phenol with linseed oil fatty acids, adipic acid, and maleic anhydride (see examples). A further embodiment reacts a 400 parts terpene-phenol with 250 parts rosin (see example 1). However, US'156 fails to disclose or suggest reacting wood rosin, tall oil rosin, and/or gum rosin with a terpene-phenol (see new Claims 21-39). Further, US'156 fails to disclose or suggest reacting rosin with terpene-phenol at a weight ratio ranging from 60/40 to 40/60 (see new Claims 40-41).

Even though US'156 discloses that 400 parts terpene-phenol can be reacted with 250 parts linseed oil fatty acids, US'156 fails to disclose whether or not "parts" is based on weight. Such information is critical to understanding the examples, and therefore, critical to Office's interpretation thereof. However, absent such disclosure and explanation, one can not understand the metes and bounds of the examples.

Even if the word "parts" in US'156 is based on weight, US'156 would only disclose, at best, reacting 61.5 parts terpene-phenol with 38.5 parts rosin (see example 1). US'156 is completely silent as to the expansion of the scope of the weight ratio from 61.5/38.5 in Example 1 towards a ratio of 60 parts terpene-phenol and 40 parts rosin. The entire specification of US/156 is silent except for Examples 3 and 4. Examples 3 and 4 of US'156 demonstrate reacting approximately 87 parts terpene-phenol with 13 parts carboxylic acid. Accordingly, US'156 suggests in the Examples weight ratios that are equal to and/or very much greater than a 61.5:38.5 terpene-phenol/rosin. Therefore, US'156 actually teaches away from a terpene-phenol/rosin weight ratio that is from 60:40 to 40:60.

Even though US'156 discloses that 400 parts terpene-phenol can be reacted with 250 parts rosin, US'156 fails to disclose or define "rosin" therein. Such information is critical to

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understanding the examples, and therefore, critical to Office's interpretation thereof.

However, absent such disclosure and explanation, one can not understand the metes and bounds of the examples. In fact, US'156 is completely barren with respect to wood rosin, tall oil rosin, and/or gum rosin (See Claims 21-39) and further fails to suggest wood rosin, tall oil rosin, and/or gum rosin altogether.

US'606, discloses, at best, a method of making a malonate group-containing acrylate monomer by transesterification reactions of dialkyl malonate with a hydroxyalkyl (meth)acrylate or polyalkylene glycol mono (meth)acrylate (see Abstract). However, US'606 fails to disclose or suggest reacting wood rosin, tall oil rosin, and/or gum rosin with a terpene-phenol (see new Claims 21-39). Further, US'606 fails to disclose or suggest reacting rosin with terpene-phenol at a weight ratio ranging from 60/40 to 40/60 (see new Claims 40-41).

The Office relies on US'606 so as to allegedly demonstrate that boric acid may be functionally equivalent as a Bronsted acid to sulfuric acids, sulfonic acids, and p-toluene sulfonic acid. No elements of the claimed invention are disclosed and/or suggested by US'606. While not commenting on the merit of the Office's position, Applicants point out that there is really no relation of US'606 to the technical art of that disclosed by US'156. Further, there is no relation of US'606 to the technical art of the present invention. Accordingly, Applicants do not understand how the disclosure of US'606 can possibly be combined with that of US'156 and applied to the claimed invention.

In direct contrast to US'156 and US'606, the present invention relates, in part, to a resin and a process for producing a resin by reacting rosin with a terpene-phenol resin in the presence of a Bronsted acid. Claims 21-39 are drawn, in part, to such subject matter when

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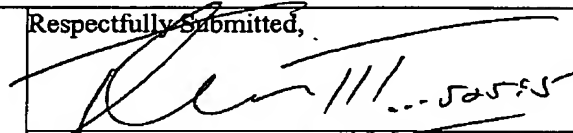
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the rosin may be at least one of a wood rosin, tall oil rosin, and gum rosin and resins made therefrom. Claims 40-41 are drawn, in part, to such subject matter when the rosin and terpene-phenol are reacted together in a rosin:terpene-phenol weight ratio of from 40:60 to 60:40 and resins made therefrom.

Since the disclosure of US'156 fails to disclose or suggest resins made from wood rosin, tall oil rosin, and gum rosin and actually teaches away from a rosin:terpene-phenol weight ratio of from 40:60 to 60:40, US'156 can not possible disclose or suggest the claimed invention. Further, since US'606 fails to disclose any element of the claimed invention and further fails to be related whatsoever to the present invention and the disclosure of US'156, any combination of US'156 with US'606 fails to provide what US'156 lacks. Accordingly, new Claims 21-41 are neither anticipated, nor suggested, by US 2,284,156 (US'156) and/or US 6,054,606 (US'606). Accordingly, withdrawal of all grounds of rejection is respectfully requested.

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Applicants respectfully submit that the present application is now in condition for allowance. Favorable reconsideration is respectfully requested. Should anything further be required to place this application in condition for allowance, the Examiner is requested to contact below-signed by telephone.

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